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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/416,526	10/12/1999	ERKKO LEHTONEN	367.37732X00	6275

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EXAMINER

TORRES, MARCOS L

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 12/13/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/416,526

Applicant(s)

LEHTONEN ET AL.

Examiner

Marcos L Torres

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 2, 3, 6, 9, 10, 12, 13, 14, 18, 20 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Sonti.

As to claim 1, Sonti discloses a method of automatically configuring services for a subscriber within a communication system, comprising the step of: sensing an external parameter (see column 8, lines 25-29); choosing for the particular subscriber, a configuration of communication services from a plurality of configurations (see column 5, lines 32-44); and using the chosen configuration in respect of the subscriber, wherein said choosing is performed in dependence

on a pre-defined criterion and the sensed external parameter (see column 1, lines 57-60).

As to claims 2 and 3, Sonti discloses a method wherein the plurality of configurations is dependent upon the subscriber and wherein the pre-defined criterion is dependent upon the subscriber (see column 6, lines 7-11).

As to claim 6, Sonti discloses a method wherein a configuration is designated to be used in the event that no other configurations meet the pre-defined criterion (see column 5, lines 62-65).

As to claim 9, Sonti discloses a method wherein the pluralities of configurations are stored in a central database of a communication system (see column 5, lines 13-15).

As to claim 10, Sonti discloses that his method wherein the configurations are stored central database is a Home Location Register and anticipated that it could be a different system (see column 5, lines 40-41 and column 9, lines 9-14).

As to claim 12, Sonti discloses a method wherein the predefined criterion is dependent upon the time (see column 1, lines 57-60).

As to claim 13, Sonti discloses a method wherein the predefined criterion is dependent upon the location of the mobile station (see column 1, lines 57-60).

As to claim 14, Sonti discloses a method wherein the predefined criterion is dependent upon the equipment identity of the mobile station (see column 5, line 65 to column 6, line 1).

As to claim 18, Sonti discloses an apparatus, for use in a communication system, comprising a register of subscribers to the communication system (see

column 4, lines 56-65); a register of alternative configurations (see column 6, lines 31-36); sensing means for sensing an external parameter (see column 1, lines 56-60); means for choosing one of the alternative configurations in response to said sensing means and a predefined criterion (see column 8, lines 25-29); and means for using the chosen configuration in respect of a particular subscriber (see column 3, lines 12-48).

As to claim 20, Sonti discloses an apparatus wherein the register of alternative configurations is associated with the subscriber (see column 2, lines 34-42).

As to claim 21, Sonti discloses an apparatus wherein pre-defined criterion is associated with the subscriber (see column 1, lines 56-60).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 4, 5, 7, 8, 11, 15, 16, 17, 19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sonti in view of Buhrmann ('778).

As to claim 4, Sonti discloses everything claimed as explained above except for a method wherein the choosing is performed each time a call is made. Buhrmann discloses a method wherein the choosing is performed each time a call is made (see column 11, lines 9-19). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add these features to the Sonti system for a more versatile system.

As to claim 5, Sonti discloses everything claimed as explained above except for a method wherein the plurality of configurations are ranked in order of priority such that one of relatively higher priority which satisfies the criterion is used before one of relatively lower priority which also satisfies the criterion. Buhrmann discloses a method wherein the plurality of configurations are ranked in order of priority such that one of relatively higher priority which satisfies the

criterion is used before one of relatively lower priority which also satisfies the criterion (see column 8, lines 20-38). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add the Buhrmann features to Sonti system for the simple purpose of increasing the flexibility of the system.

As to claim 7, Sonti do not specifically disclose a method wherein the automatic process may be manually overridden to use a configuration. However the use of manually override an automatic process is a common and well known technique, for example stopping a voice mail system, silence an incoming call, etc. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this feature to the Sonti system for more convenience.

As to claim 8, Sonti do not specifically disclose a method wherein use of a certain configuration is not permitted according to a predefined rule. However, denial of a service or features when they are not valid in predefined rule is a common and well-known technique. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this feature to the Sonti system to minimize errors.

As to claim 11, Sonti discloses everything claimed as explained above except for the method wherein the predefined criterion is dependent upon the date. Buhrmann discloses a method wherein the predefined criterion is dependent upon the date (see column 6, lines 32-42). Therefore, it would have

been obvious to one of the ordinary skill in the art at the time of the invention to combine these techniques to further automate the Sonti system.

As to claim 15 and 16, Sonti discloses everything claimed as explained above except for the method wherein the predefined criterion is dependent upon the number or type called. 15. Buhrmann discloses a method wherein the predefined criterion is dependent upon the number or type called (see column 8, lines 25-31). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add the feature of Buhrmann to system of Sonti for a more versatile system.

As to claim 17, Sonti discloses everything claimed as explained above except for a method wherein a configuration is chosen according to a plurality of predefined criteria. Buhrmann discloses a method wherein a configuration is chosen according to a plurality of predefined criteria (see column 8, lines 5-19). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add the feature of Buhrmann to system of Sonti for an easier updating system.

As to claim 19, Sonti discloses an apparatus wherein said registers form part of the Home Location Register (HLR). Sonti do not specifically disclose the use of his system in a GSM communication system. However, it would be obvious to one of the ordinary skill in the art at the time of the invention to use the Sonti system in an equivalent communication system.

As to claim 23, Sonti discloses everything claimed as explained above except for an apparatus or method wherein the external parameter is a hardware

parameter. Buhrmann discloses an apparatus or method wherein the external parameter is a hardware parameter (see column 6, lines 43-59). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add a hardware parameter to the Sonti system for more enhanced functions.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The use of an external parameter consisting on an environmental parameter is not supported in the specification.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Reichelt U.S. Patent 6,295,447 discloses a method and system for enabling the control of execution of features in a telecommunication network.
- b. Vossler U.S. Patent 6,317,593 discloses an intelligent cellular telephone function.

- c. Irvin U.S. Patent 6,195,568 discloses a radiotelephone adapted to the identity of its user.
- d. Valliani U.S. Patent 6,311,063 discloses a method of and system for emulation of multiple subscriber profiles on a single mobile phone in a wireless telecommunication network.
- e. Choquet U.S. Patent 6,178,324 discloses a method of adapting the operation of a subscriber identity module to one or more interfaces of a mobile radio communication terminal.
- f. Huotari U.S. Patent 6,044,264 discloses a method for activating intelligent network services in a mobile communication system, and a mobile communication system.
- g. Miller U.S. Patent 6,141,563 discloses a SIM card secured subscriber unit.
- h. Buhrmann U.S. Patent 5,903,845 discloses a personal information manager for updating telecommunication subscriber profile.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcos L Torres whose telephone number is 703-305-1478. The examiner can normally be reached on 8:00am-5:30pm alt. Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William G Trost can be reached on 703-305-5318. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Marcos L Torres
Examiner
Art Unit 2683

mlt
December 10, 2001


EDWARD F. URBAN
PRIMARY EXAMINER